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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,973	01/15/2002	Jun Nagasawa	S004-4521	5925

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EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/047,973	Applicant(s) NAGASAWA, JUN	
	Examiner Adam M. Queler	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Substitute specification filed 12/01/2005 (correct marked up copy filed 03/22/2006), and Amendment and Remarks filed 08/08/2005
2. Claims 1-8, and 11-19 are pending in the case. Claims 1 and 13 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in JAPAN on 01/24/2001. It is noted, however, that applicant has not filed a certified copy of the 2001-016297 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 2, 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (EP000585192A3, published 3/2/1994), and further in view of Winer (US005796401A, published 8/18/1998).**

Regarding independent claim(s) 1, Carroll teaches a display monitor for displaying an image (Fig. 1) and items in a list (Fig. 2). Carroll teaches a dragging and dropping an item to a desired position and attaching the item to existing group (col. 6, ll. 35-49). Carroll does not explicitly disclose group editing. Winer discloses group editing of the items (col. 3, ll. 13-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine

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Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

Carroll and Winer do not explicitly disclose that the contents of the reports or items are analysis results. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the items corresponded to analysis results or anything else. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display and position any type of content. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding dependent claim(s) 2, Carroll does not explicitly disclose group editing. Winer discloses group editing of the items, including character position alignment (col. 3, ll. 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

Regarding dependent claim(s) 4, Carroll does not explicitly disclose group editing. Winer discloses group editing of the items, including position adjustment (col. 3, ll. 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine

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Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

Regarding independent claim(s) 13, Carroll teaches a display monitor for displaying an image (Fig. 1) and individually selectable items in a list (Fig. 2). Carroll teaches a dragging and dropping an item to a desired position and attaching the item to existing group (col. 6, ll. 35-49). Carroll does not explicitly disclose group editing. Winer discloses group editing of the items (col. 3, ll. 13-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

6. Claims 3, 5-8, 11-12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll and Winer, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim(s) 3, Carroll does not explicitly disclose group editing. Winer discloses group editing of the items' attributes, including color (col. 8, ll. 27-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

Winer does not explicitly disclose fonts. Applicant admits the font was a display attribute to be changed in the prior art (p. 3, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to group edit the font rather than editing each item individually in order to save time (Winer, col. 2, ll. 40-50) and extend the improvement to an attribute that it was common place to edit.

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Regarding dependent claim(s) 5-8, Neither Carroll nor Winer explicitly discloses analysis reports. Applicant admits an analysis report including a title and contents were well-known in the prior art. It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the obvious group editing of item (as explained in the rejections above) to analysis reports as they were a well-known type of document and would benefit from the group timesaving features of group editing (Winer, col. 2, ll. 40-50).

Additionally, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the items corresponded to analysis results or anything else. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display and position any type of content. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding dependent claim(s) 11-12, Carroll does not explicitly disclose group editing. Winer discloses group editing of the items, including character position alignment (col. 3, ll. 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer to eliminate the time consuming task of editing items one at a time (Winer, col. 2, ll. 40-50).

Regarding dependent claim(s) 14, Carroll and Winer teach selectable items as described in claim 13 above. Neither Carroll nor Winer explicitly discloses analysis reports. Applicant admits an analysis report was well-known including characteristics of a sample and descriptive parameters (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the obvious group editing of item (as explained in the rejections above) to analysis reports as they were a well-known type of document and would benefit from the group timesaving features of group editing (Winer, col. 2, ll. 40-50).

Additionally, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the items corresponded to analysis results or anything else. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display and position any type of content. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding dependent claim(s) 15, Carroll and Winer teach selectable items as described in claim 13 above. Neither Carroll nor Winer explicitly discloses analysis reports. Applicant admits an analysis report was well-known including measurement parameters (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the obvious group editing of item (as explained in the rejections above) to analysis reports as they

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were a well-known type of document and would benefit from the group timesaving features of group editing (Winer, col. 2, ll. 40-50).

Additionally, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the items corresponded to analysis results or anything else. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display and position any type of content. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding dependent claim(s) 16, Carroll and Winer teach selectable items as described in claim 13 above. Neither Carroll nor Winer explicitly discloses analysis reports. Applicant admits an analysis report was well-known including sample names and analysis dates (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the obvious group editing of item (as explained in the rejections above) to analysis reports as they were a well-known type of document and would benefit from the group timesaving features of group editing (Winer, col. 2, ll. 40-50).

Regarding dependent claim(s) 17, Carroll and Winer teach selectable items as described in claim 13 above. Carroll does not specifically mention a menu bar with a menu to change display attributes. Winer teaches menu in a menu bar to change display attributes (Fig. 3). It would

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have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer in order to provide an interface for changing attributes (Winer, col. 5, ll. 35-40).

Regarding dependent claim(s) 18, Carroll and Winer teach selectable items as described in claim 13 above. Carroll does not specifically mention a menu bar with a menu to change display attributes. Winer teaches menu in a menu bar to change display attributes (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer in order to provide an interface for changing attributes (Winer, col. 5, ll. 35-40). Neither Carroll nor Winer explicitly disclose font or color as the attributes. Applicant admits font and color were display attributes to be changed in the prior art (p. 3, line 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to group edit the font and color rather than editing each item individually in order to save time (Winer, col. 2, ll. 40-50).

Regarding dependent claim(s) 19, Carroll and Winer teach selectable items as described in claim 13 above. Carroll does not specifically mention a menu bar with a menu to change display attributes. Winer teaches menu in a menu bar to change display attributes, including alignment (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carroll and Winer in order to provide an interface for changing attributes (Winer, col. 5, ll. 35-40).

Response to Arguments

7. Applicant's arguments filed 8/08/2005 have been fully considered but they are not persuasive.

Applicant's amendment's and arguments are mainly concerned with the addition of "analysis reports" as a qualifier for most of the elements. However, this is merely non-functional descriptive data. The differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. All the steps of the function would be performed the same way regardless of whether or not the items corresponded to analysis results or anything else. Applicant even describes these differences as "descriptive parameters" (p. 26, last line) Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display and position any type of content. because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Assuming *arguendo* the hindsight was improper, the claimed differences are still in non-functional descriptive data as explained above and in the rejections.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AQ


STEPHEN HONG
SUPERVISORY PATENT EXAMINER